



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/521,868	08/30/2005	Rejean Tremblay	701826-056380	1243

7590
David S. Resnick
Nixon Peabody
100 Summer Street
Boston, MA 02110-2131

08/13/2010

EXAMINER

MARX, IRENE

ART UNIT

PAPER NUMBER

1651

MAIL DATE

DELIVERY MODE

08/13/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Art Unit: 1651

Note:

The proposed amendment raises new issues that would require further consideration and/or search with respect to the replacement of *Chaetocerotaceae* or *Skeletonemacea* with *Chaetoceros gracilis* or *Skeletonema costatum* in claims 13 and 14 in the context of producing omega-3-polyunsaturated acids or increasing the yield of omega-3-polyunsaturated acids with silicate deprivation at the end of the exponential growth phase.

Response to Arguments

Applicant's arguments have been fully considered to the extent that they pertain to the claims now of record but they are not deemed to be persuasive.

It should be kept in mind that applicant cannot, as a matter of right, amend any finally rejected claims, add new claims after a final rejection (see **37 CFR 1.116**) or reinstate previously canceled claims.

Except where an amendment merely cancels claims, adopts examiner suggestions, removes issues for appeal, or in some other way requires only a cursory review by the examiner, compliance with the requirement of a showing under **37 CFR 1.116(b)(3)** is expected in all amendments after final rejection, i.e., "An amendment touching the merits of the application or patent under reexamination **may be admitted upon a showing of good and sufficient reasons why the amendment is necessary and was not earlier presented.**"

Regarding the new matter rejection, claims 1 and 2 are included in the rejection to the extent that they depend on claim 12.

Regarding the obviousness rejection, applicant argues that the claims are being misconstrued, since "at the end of exponential phase" is not the same as "after the end of exponential phase". However, applicant has not indicated where in the as-filed specification the terminology "at the end of exponential phase" is defined to pinpoint what is intended with any precision. There is nothing on this record to suggest that "at the end of exponential phase" means that this is the time of "peak exponential growth" as suggested by the current arguments. Also applicant has not shown that the timing of "applying" of any growth limiting factor has

Art Unit: 1651

significant effects on the production of polyunsaturated fatty acids for any *Chaetocerotaceae* or *Skeletonemacea* or even for any *Chaetoceros gracilis* or *Skeletonema costatum* regardless of the extent of "deprivation" and the nature of the "growth limiting factor".

The scope of the showing must be commensurate with the scope of claims to consider evidence probative of unexpected results, for example. In re Dill, 202 USPQ 805 (CCPA, 1979), In re Lindner 173 USPQ 356 (CCPA 1972), In re Hyson, 172 USPQ 399 (CCPA 1972), In re Boesch, 205 USPQ 215, (CCPA 1980), In re Grasselli, 218 USPQ 769 (Fed. Cir. 1983), In re Clemens, 206 USPQ 289 (CCPA 1980). It should be clear that the probative value of the data is not commensurate in scope with the degree of protection sought by the claim.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Irene Marx whose telephone number is (571) 272-0919. The examiner can normally be reached on M-F (6:30-3:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Wityshyn can be reached on 571-272-0926. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300 .

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Irene Marx/
Primary Examiner
Art Unit 1651